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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,412	08/25/2003	Robert B. Harkness	2747-66693	4022

7590 07/08/2005

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EXAMINER

LOCKER, HOWARD J

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698412

Applicant(s)

Harkness, et al.

Examiner

Howard J. Locker

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/25/03, petition decision of 12/14/04 and telephonic interview of 6/6/05
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ ~~Claim(s)~~ The claim is ~~is~~ pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ ~~Claim(s)~~ The claim is ~~is~~ rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other Requirement for information under 37 CFR 1.105
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

Office Action Summary

1. This communication (most specifically the modified Requirement for Information under 37 CFR 1.105) is set forth subsequent to the judgment by the United States Court of Appeals for the Federal Circuit in *Zary* and *Elsner*, in which the decision by the United States Patent and Trademark Office Board of Patent Appeals and Interferences was vacated and remanded.

More specifically, the CAFC remanded these cases for "further factual findings relating to the accessibility of the foreign sales of the claimed plants and the reproducibility of the claimed plants from the plants that were sold."

The previous communication by the Office (mailed 03/03/05) is vacated in favor of the instant communication, which correctly sets forth the standards as regards the requirement for information under 37 CFR 1.105 (per the CAFC decisions), as well as the other remaining outstanding issues (such having been lessened from those previously of record as the result of applicant's express abandonment of parent case 09/255107, on April 15, 2005).

Copies of the references of record are NOT being included with this Office action, nor is a new PTO-892 being furnished, as there is no change therein from the Office action which was mailed on 03/03/05.

2. In the preliminary amendment (filed August 25, 2003), applicant incorrectly and improperly attempted to claim priority to parent application 09/255107 as well as incorporating same by reference, rather than reciting that the instant application is a continuation of same. Correction is necessary responsive to this Office action.

3. Pursuant to the petition decision rendered by TC1600 Director Jasmine C. Chambers on December 14, 2004, this application was returned to the examiner "for further action" on the merits.

4. The Genus/species designation for the instant plant should be set forth at the top of page 1 of the specification.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) is rejected under 35 U.S.C. 102(b) as the instant plant 'HARyup' was described in the following printed publications more than one year prior to the date of application for Plant Patent (February 22, 1999) in the United States:

(1) NZ PBR ROS511 (application and denomination published January 14, 1995), which matured into Grant/Reg. Number 1131 (published October 14, 1996); and

(2) GB Grant/Reg. Number 5467 (published January 1, 1994).

At page 2 of the October 01, 2001 response in parent application 09/255107, applicants have admitted that "the rose variety of the subject application was placed on public sale in the United Kingdom in November, 1992". In the copy of the above referenced GB document (furnished by applicants in the parent application and received into the record on April 21, 2003 by facsimile transmission) it is set forth that the first offer for sale occurred in October 1992 in the UK.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art

could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could obtain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP 2121.03.

It has been determined, and explicitly conceded on the record by applicants, that the above publicly available publications disclose the claimed plant variety and that the claimed variety was place on public sale (at least in the United Kingdom in October and November of 1992) more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published applications, accepted denomination, and published grant relied upon, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to have reproduced the plant. Information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The test of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, when combined with the knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The admission of prior sale and offer for

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sale more than one year prior to the filing date of the instant application enables the referenced documents because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have had the knowledge of how to do so, given the notoriety of various methods of asexual propagation in the Genus *Rosa*, as evidenced by the Huxley, et al, excerpt (for example at page 1112). See also *Thomson*, supra, as well as Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16 (August 2000), Clark, Boardman, Callaghan ("In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.").

6. Acknowledgement is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon application 5/1357, stated in applicants declaration to have been filed in the UK on 7/20/92 (this filing date looks to be incorrect). A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based upon said application, since the United States application 09/255107 was filed more than twelve months thereafter.

7. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

8. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

9. References cited during prosecution of the parent application have once again been made of record. Applicant's attention is directed to the Huxley, et al. excerpt, which is newly cited to show the conventionality of asexual reproduction in the Genus *Rosa*. A copy of same was included with the previous Office action.

10. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.


Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306. The new central fax number for official correspondence is 571-273-8300.

Howard J. Locker/hjl

June 13, 2005


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 35 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. The information is required to determine the accessibility of the foreign sales and the reproducibility of the plants that were sold to the public, more than one year prior to the effective filing date of this application.

The information is required to determine when, and to what extent, the claimed plant variety 'HARyup', was publicly available prior to the filing date of the instant application.

In response to this requirement, please provide (to the extent not already provided):


- (a) a copy of any plant breeder's rights applications, published proposed denominations, and breeder's rights grants, relating to the claimed plant variety;
- (b) a copy of any publications or advertisements relating to sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world if the sale, offer for sale, or public distribution occurred more than one year prior to the effective filing date of this application;
- (c) any public information available regarding sales, offers for sale, or public distributions of the claimed plant variety anywhere in the world which occurred more than one year prior to the effective filing date of this application, including the date(s) and location(s), as well as whether this was an obscure, solitary occurrence that would go unnoticed by those skilled in the art; and
- (d) any information relating to the accessibility or non-accessibility of the claimed plant that one of ordinary skill in the art could have derived from the printed PBR document(s).

The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant or the assignee can readily obtain the requested documents and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in response to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. If an item required by the examiner is unknown to the applicant, a statement that the item is unknown to applicant will be accepted as a complete response to the requirement for that item. Where the applicant does not have and cannot readily obtain an item of required information, a statement that the item cannot readily be obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment to the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for response to this requirement coincides with the time period for response to the attached Office action, which is three (3) months.


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661